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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/220,910	12/24/1998	THOMAS E. WALSH	2207-6033	5446

7590 07/30/2003

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EXAMINER

VU, THONG H

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 07/30/2003

15

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**JUL 29 2003**

**Technology Center 2100**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 15

Application Number: 09/220,910  
Filing Date: December 24, 1998  
Appellant(s): WALSH, THOMAS E.

\_\_\_\_\_  
David R. Schaffer  
For Appellant

**EXAMINER'S ANSWER**

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This is in response to the appeal brief filed 5/12/03.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 2,5-15,17-21,23-41 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

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**(9) Prior Art of Record**

5,526,520	KRAUSE	6-1996
6,327,612 b1	WANATABE	12-2001
5,675,507	BOBO, II	10-1997
5,870,089	FABBIO et al	2-1999

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 2,17,23,30,33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention (i.e.: processing said primary document to locate an un-selected indicator -claims 2,23,33; and identifying a secondary document having an un-specified location from a primary document-claims 17,30).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. Claims 2-9,12-15,17-21,23-41 are rejected under 35 U.S.C. § 103 as being obvious over Krause [5,526,520] in view of Wanatabe [6,372,612 B1]

3. As per claims 2,27 Krause discloses a method for identifying a secondary document having an un-specified location relative to a primary document in a document preparation environment comprising:

determining if said primary document includes an indicator (i.e.: file name)

[Krause col 3 lines 62-65]; and

identifying said secondary document (i.e.: additional text, audio, video) by determining at least one of a filename and a location of said secondary document (i.e.: file name and label) [Krause col 4 lines 44-50] using at least one of a user input [Krause col 4 lines 51-65], a user selection and syntactic processing (i.e.: sign, symbol, drawing, graphic, icon) of said primary document, if said primary document includes said indicator [Krause col 3 lines 28-43, col 4 lines 15-65, col 9 line 28-col 10 line 5, col 10 lines 6-27]

Krause is silent to attaching said secondary document to said primary document to encapsulate said primary and secondary documents together, if said primary document includes said indicator. It is well-known in the e-mail art that the email as the first document could has an attached document as secondary document. A skilled artisan would have motivation to implement Krause's apparatus and found Watanabe, Watanabe, in a same endeavor, discloses an email processing system including the email body text as the first document and the second document as an attachment file

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embedded in email message (i.e.: text, graphic, symbols) [Wanatabe col 9 lines 60-col 10 line 2]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the Krause and Wanatabe's teaching in order to utilize the technique of embedded a message into an email body. Doing so it would provide the fast and easy way to send the multi attached files to client through a message such as an email on Internet.

As per claims 17,23,30,33 Krause-Wanatabe disclose a system for identifying a secondary document having an un-specified location from a primary document comprising:

- a first storage device storing said primary document (i.e.: data creation)  
[Wanatabe Fig 3];

- a second storage device storing said secondary document (i.e.: database)  
[Wanatabe Fig 3];

- a third storage device storing an indicator (i.e.: recipient address input)  
[Wanatabe Fig 3];

- a processor [Wanatabe col 7 lines 15-28] coupled to said first storage device; said second storage device and said third storage device, said processor determining if said primary document includes said indicator, identifying said secondary document by determining at least one of a file name and a location of said secondary document using at least one of user input, a user selection and syntactic processing if said primary document includes said indicator, attaching said secondary document to said primary

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document to encapsulate said primary and secondary documents together, if said primary document includes said indicator [see rejection claims 1,27].

Examiner takes an Official notice that a database server / router and administrator server could be located on the same or different machine.

4. As per claims 5,18,24 Krause-Wanatabe disclose said primary document includes at least one word, and wherein determining at least one of said file name and said location of said secondary document is performed as a function of said at least one word as an inherent feature of frame name [Krause col 6 line 35-col 7 line 28].
5. As per claims 6,34 Krause-Wanatabe disclose said primary document includes a plurality of words, and wherein determining at least one of said filename and said location of said secondary document is performed as a function of said plurality of words within a predetermined proximity of said indicator included in said plurality of words as an inherent feature of frame name [Krause col 6 line 35-col 7 line 28].
6. As per claims 7, 19 Krause-Wanatabe disclose associating a predetermined word with at least one of said filename and said location of said secondary document, wherein said primary document includes said predetermined word, and wherein identifying at least one of said filename and said location of said secondary document is performed as a function of said predetermined word as an inherent feature of frame name [Krause col 6 line 35-col 7 line 28].
7. As per claims 8,20,25,28 Krause-Wanatabe disclose said indicator includes at least one of a plurality of predetermined words, a plurality of predetermined characters,

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and a plurality of predetermined phrases as an inherent feature of frame name [Krause col 6 line 35-col 7 line 28].

8. As per claims 9,21,26 Krause-Wanatabe disclose determining if said at least one word includes one of said indicator is performed using syntactic processing or menu [Krause col 6 line 35-col 7 line 28].

9. As per claim 10, Krause-Wanatabe disclose the primary document is an email message [Wanatabe col 2 lines 34-52].

10. As per claim 11, Krause-Wanatabe disclose disclose sending said e-mail message and said secondary document attached thereto to a recipient via a communications device [Wanatabe col 3 lines 15-57].

11. As per claim 12, Krause-Wanatabe disclose sending said primary document and said secondary document attached thereto to a printing device [Krause col 2 line 48].

12. As per claim 13, Krause-Wanatabe disclose said primary document and said secondary document attached thereto to a recipient via facsimile or scanner [Krause col 2 line 48].

13. As per claim 14, Krause-Wanatabe disclose said secondary document is attached to said primary document at a first instance, said first instance being determined as a function of a user input [Krause col 6 lines 35-45].

14. As per claims 15,36,37 Krause-Wanatabe disclose adding at least one additional indicator to said indicator as a function of a user input (or selection) [Krause col 6 lines 35-45][Wanatabe col 3 line 58-col 4 line 3,col 7 lines 55-67,col 9 lines 35-43, col 12 lines 12-23].



15. As per claim 29, Krause-Wanatabe disclose said primary document includes a list of at least one address corresponding to at least one recipient to receive said primary document, further comprising attaching said address of said recipient to said list of said at least one address as inherent feature of email message wherein an email is primary document includes an indicator as an address of recipient [Wanatabe col 3 lines 15-57].

16. Claims 2-15,17-21,23-41 are rejected under 35 U.S.C. § 103 as being obvious over Bobo, II [5,675,507] in view of Fabbio [5,870,089]

17. As per claims 2,27 Bobo discloses the invention as substantially as claimed, a method for message storage and delivery system wherein a second document (i.e.: HTML image) is embedded into a first document (i.e.: facsimile message) [Bobo col 9 line 47-col 10 line 25,col 21 lines 55-60, col 22 lines 49-60] which is equivalent to a method for identifying a secondary document having an un-specified location relative to a primary document in a document preparation environment;

determining if said primary document includes an indicator (i.e.: message ID, address, file name) [Bobo col 7 lines 38-50]; and

attaching said secondary document to said primary document to encapsulate said primary and secondary documents together, if said primary document includes said indicator [Bobo col 9 line 46-col 10 line 14]

Bobo is silent to detail identifying said secondary document by determining at least one of a filename and a location of said secondary document using at least one of

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a user input, a user selection and syntactic processing (i.e.: sign, symbol, drawing, graphic, icon) of said primary document, if said primary document includes said indicator. It is well-known in the e-mail art that the email as the first document could have an attached document as secondary document. A skilled artisan would have motivation to implement Bobo's apparatus and found Fabbio. Fabbio, in a same endeavor, discloses an electronic package processing system (i.e.: email, facsimile message) including the document references such as file names and locations [Fabbio, abstract, Fig 1, col 2 lines 38-55, col 3 lines 4-44, 58-col 4 lines 25]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the Fabbio into Bobo's teaching in order to utilize the technique of embedded or attached a second message into the first message. Doing so it would provide the fast and easy way to send the attached files to client through a large network such as Internet.

18. As per claims 17,23,30,33 Bobo-Fabbio disclose a system for identifying a secondary document having an un-specified location from a primary document comprising:

- a first storage device storing said primary document [Bobo Fig 13-15];
- a second storage device storing said secondary document [Bobo Fig 13-15];
- a third storage device storing an indicator [Bobo Fig 13-15];
- a processor [Bobo Fig 13-15] coupled to said first storage device; said second storage device and said third storage device, said processor determining if said primary document includes said indicator, identifying said secondary document by determining

at least one of a file name and a location of said secondary document using at least one of user input, a user selection and syntactic processing if said primary document includes said indicator, attaching said secondary document to said primary document to encapsulate said primary and secondary documents together, if said primary document includes said indicator [see rejection claims 1,27].

19. As per claims 5,18,24 Bobo-Fabbio disclose said primary document includes at least one word, and wherein determining at least one of said file name and said location of said secondary document is performed as a function of said at least one word locations [Fabbio, abstract, Fig 1, col 2 lines 38-55,col 3 lines 4-44, 58-col 4 lines 25].

20. As per claims 6,34 Bobo-Fabbio disclose said primary document includes a plurality of words, and wherein determining at least one of said filename and said location of said secondary document is performed as a function of said plurality of words within a predetermined proximity of said indicator included in said plurality of words locations [Fabbio, abstract, Fig 1, col 2 lines 38-55,col 3 lines 4-44, 58-col 4 lines 25].

21. As per claims 7, 19 Bobo-Fabbio disclose associating a predetermined word with at least one of said filename and said location of said secondary document, wherein said primary document includes said predetermined word, and wherein identifying at least one of said filename and said location of said secondary document is performed as a function of said predetermined word locations [Fabbio, abstract, Fig 1, col 2 lines 38-55,col 3 lines 4-44, 58-col 4 lines 25].

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22. As per claims 8,20,25,28 Bobo-Fabbio disclose said indicator (i.e.: references) includes at least one of a plurality of predetermined words, a plurality of predetermined characters, and a plurality of predetermined phrases locations [Fabbio, abstract, Fig 1, col 2 lines 38-55,col 3 lines 4-44, 58-col 4 lines 25].

23. As per claims 9,21,26 Bobo-Fabbio disclose determining if said at least one word includes one of said indicator is performed using syntactic processing [Bobo Fig 15][Fabbio Fig 7-7A].

24. As per claim 10, Bobo-Fabbio disclose the primary document is an email message locations [Fabbio, abstract, Fig 1-2, col 2 lines 38-55,col 3 lines 4-44, 58-col 4 lines 25].

25. As per claim 11, Bobo-Fabbio disclose sending said e-mail message and said secondary document attached thereto to a recipient via a communications device locations [Fabbio, abstract, Fig 1-2, col 2 lines 38-55,col 3 lines 4-44, 58-col 4 lines 25].

26. As per claim 12, Bobo-Fabbio disclose sending said primary document and said secondary document attached thereto to a printing device [Fabbio abstract].

27. As per claim 13, Bobo-Fabbio disclose said primary document and said secondary document attached thereto to a recipient via facsimile or scanner locations [Fabbio, abstract, Fig 1-2, col 2 lines 38-55,col 3 lines 4-44, 58-col 4 lines 25].

28. As per claim 14, Bobo-Fabbio disclose said secondary document is attached to said primary document at a first instance, said first instance being determined as a function of a user input locations [Fabbio, abstract, Fig 1-7A, col 2 lines 38-55,col 3 lines 4-44, 58-col 4 lines 25].

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29. As per claims 15,35,36 Bobo-Fabbio disclose adding at least one additional indicator to said indicator as a function of a user input locations [Fabbio, abstract, Fig 1-7A, col 2 lines 38-55,col 3 lines 4-44, 58-col 4 lines 25].

30. As per claim 29, Bobo-Fabbio disclose said primary document includes a list of at least one address corresponding to at least one recipient to receive said primary document, further comprising attaching said address of said recipient to said list of said at least one address locations [Fabbio, abstract, Fig 1, col 2 lines 38-55,col 3 lines 4-44, 58-col 4 lines 25].

31. As per claims 35,38 Bobo-Fabbio disclose using syntactic processing (or natural language processing) of said primary document as inherent feature of primary document or file.

32. As per claims 39-41 Bobo-Fabbio disclose processing said primary document to locate one of a plurality of pre-determined phrase/words/characters as inherent feature of primary document or file.

**(11) Response to Argument**

**An indefinite claim**

33. As per claims 2,17,23,30,33 applicant argues the phrase “un-specified location” is clearly and unambiguously defined by, at least, the description of Fig 2 , which is states that “processor 10 may receive a user input indicating the file name and/or location of a secondary document 60”.

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Examine notes First, the term "un-specified location" did not exist in the specification [pp1-10]. Second, all Fig 1-7 did not define how "un-specified location" is and did not disclose "un-specified location" properly in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. An ordinary skilled in the art can not relate how an un-selected indicator /location/address which associated with an secondary document without any specific description (i.e.: protocol, rule, filter, tag, Identifier) and in other view point how a secondary document could identify and associate to one among indefinite indicator. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

**An omnibus type claim**

34. As per claims 2,17,23,30,33 applicant argues claims in utility applications that define the invention entirely by reference to the specification and/or drawing.

Examine point out the specification and drawing did not disclose How the un-selected indicator/location/ address represents in quatity, format, characteristics, etc (as per claim 6 disclose said un-selected indicator includes a plurality of words, examiner interprets words as an URL). These claims are an omnibus type claim.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

**Thong Vu**  
**Patent Examiner**  
**Art Unit 2142**



July 28, 2003

Conferees

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